



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

| APPLICATION NO.                                                              | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.   | CONFIRMATION NO. |
|------------------------------------------------------------------------------|-------------|----------------------|-----------------------|------------------|
| 10/680,918                                                                   | 10/08/2003  | Scott S. Firestone   | 062891.1122           | 7590             |
| 5073                                                                         | 7590        | 06/07/2006           | EXAMINER              |                  |
| BAKER BOTTS L.L.P.<br>2001 ROSS AVENUE<br>SUITE 600<br>DALLAS, TX 75201-2980 |             |                      | RAMAKRISHNAIAH, MELUR |                  |
|                                                                              |             |                      | ART UNIT              | PAPER NUMBER     |
|                                                                              |             |                      | 2614                  |                  |

DATE MAILED: 06/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/680,918

**Applicant(s)**

FIRESTONE ET AL.

**Examiner**

Melur Ramakrishnaiah

**Art Unit**

2614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 10-8-03.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**Double Patenting**

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-34 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1-26 of U.S. Patent No.6,989,856. Although the conflicting claims are not identical, they are not patentably distinct from each other because for example claim 1 of the present application is an obvious variation of claim 1 of U.S. Patent No.6,989,856.

Note: in response to Applicant's Appeal brief, Final rejection of claims 1-34 is withdrawn in view of Applicants lack of disclosure to support claim limitation set forth in the independent claims 1, 11, 19, 27 as set forth below.

**Claim Rejections - 35 USC § 112**

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

Art Unit: 2614

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-34 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. For example independent claim 1 has limitation such as audio mixer being able to create a mixed stream which includes audio and video data, that may be communicated to one or more of the end points such that end points do not have to have to perform audio mixing. Regarding this limitation, there is no disclosure in the applicant's specification to support this disclosure. Applicant's specification discloses audio mixer only that mixes audio signals and it does not create a mixed stream which includes audio and video stream as claimed in claim 1 of the applicant's invention. Similar limitation are included in other independent claims 11, 19, 27.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-8, 11-18, 19-26, 27-34 rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al. (US PAT: 6,128,649, hereinafter Smith) in view of Nelson (US2004/0008635A1, hereinafter Nelson, filed 7-10-2002).

Regarding claim 1, Smith discloses an apparatus for executing a video conference, comprising: an audio mixer operable to receive one or more audio streams associated with video conference from one or more end points and to determine active speaker associated with one of the end points (fig. 5, col. 8 lines 12-22), one or more media switches in (12, fig. 20, col. 27 lines 11-30, col. 6 lines 63-67, col. 7 lines 1-3) operable to receive audio information associated with the active speaker, wherein one or more of audio switches are operable to suppress one or more video streams except for a selected video stream associated with the active speaker, the selected video stream propagating to one or more media switches during the video conference, and wherein a selected one of the media switches is operable to replicate the selected video stream such that it may be communicated to one or more end points associated with the selected media switch (col. 18 lines 36-39, col. 19 lines 3-21).

Regarding claims 11, 19 and 27, Smith discloses the following: receiving one or more audio streams associated with a video conference from one or more points (fig. 20), determining the active speaker with one of the end points, receiving audio information associated with the active speaker at one or more audio switches in (12, fig. 20, col. 6 lines 63-67, col. 7 lines 1-3), suppressing one or more video streams except for a selected video stream associated with the active speaker, the selected video stream propagating to one or more of the media switches during the video conference, replicating the selected video stream such that it may be communicated to one or more of the end points associated with a selected one of the media switches (col. 18 lines 36-39, col. 19 lines 3-21, fig. 4, col. 6 lines 49-62).

Art Unit: 2614

Smith differs from claims 1, 11, 19 and 27 in that although he discloses Multipoint Control Unit (MCU) to distribute media streams to the end points in a video conference (col. 6 lines 53-65); he does not explicitly teach the following: audio mixer being central to the video conference and residing in a network, the audio mixer being able to create a mixed stream which includes audio and video data, that may be communicated to one or more of the end points such that end points do not have to perform audio mixing.

However, Nelson discloses multi-participant conference system which teaches the following: audio mixer (reads on media mixer 132, fig. 4) being central to the video conference and residing in a network, the audio mixer being able to create a mixed stream which includes audio and video data, that may be communicated to one or more of the end points such that end points do not have to perform audio mixing (paragraphs: 0049, 0054).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Smith's system to provide for the following: audio mixer being central to the video conference and residing in a network, the audio mixer being able to create a mixed stream which includes audio and video data, that may be communicated to one or more of the end points such that end points do not have to perform audio mixing as this arrangement would facilitate providing media processing at a central location as taught by Nelson, thus relieving the end terminals of the burden of audio processing which contributes to economical implementation of video conference system.

Art Unit: 2614

Regarding claims 2-8, 12-18, 20-26, 28-34, Smith further teaches the following: selected video stream propagates to one or more media switches during video conference using a multicast protocol (col. 6 lines 66-67, col. 7 lines 1-3), performing selected one of a multicast and a unicast operation (reads on receiving lecture, col. 19 lines 9-12) between the selected media switch and the end points associated with the selected media switch (col. 6 lines 66-67, col. 7 lines 1-3), selected media switch is operable to enable a selected one of the end points associated with the video conference to lock on to a participant of the video conference, the selected end point propagating a fixed video (FV) stream associated with the video conference, a selected media switch is operable to control whether a selected one of the end points receives an FV stream, a switched video (SV) stream, or any combination thereof (col. 18 lines 34-39, col. 19 lines 23-45), selected one of the endpoints does not receive an SV stream based on the active speaker, and wherein the selected one of the media switches is operable to enable a selected one of the end points to receive only the SV stream based on a selected whiteboard control feature (col. 19 lines 47-60), selected one of the media switches is operable to enable a moderator (reads on chairperson) of the conference to control a video source such that a selected one of the endpoints receive a selected video stream as determined by the moderator (col. 19 lines 62-67), a media bridge is operable to provide one or more media services for the video conference such that one or more of the media services are delivered to one or more of the endpoints (col. 6 lines 63-67, col. 7 lines 1-3).

7. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smith in view of Nelson as applied to claim 1 above, and further in view of Feder et al. (US PAT: 6,300,973 B1, hereinafter Feder).

Regarding claim 9, the combination does not explicitly teach the following: media bridge includes a selected one or more of a media transformer, transcoder, and transrater.

However, Feder discloses method and system for multimedia communication control which teaches the following: media bridge includes a selected one or more of a media transformer, transcoder, and transrater (fig. 6 col. 8 lines 38-43).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify the combination to provide for the following: media bridge includes a selected one or more of a media transformer, transcoder, and transrater as this arrangement would facilitate performing translation operation to accommodate different kinds end points in video conference as taught by Feder (col. 2 lines 15-21).

8. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smith in view of Nelson as applied to claim 1 above, and further in view of Tucker et al. (US PAT: 6,590,604, hereinafter Tucker).

Regarding claim 10, the combination does not teach the following: a gateway operable to provide connectivity to one or more media switches, one or more media switches being operable to facilitate participation in the video conference by the first and second end points.

Art Unit: 2614

However, Tucker discloses a personal videoconferencing system which teaches the following: a gateway (708/716, fig. 7) operable to provide connectivity to one or more media switches, one or more media switches being operable to facilitate participation in the video conference by the first and second end points (fig. 7 col. 9 lines 40-63).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify the combination to provide for the following: a gateway operable to provide connectivity to one or more media switches, one or more media switches being operable to facilitate participation in the video conference by the first and second end points as this arrangement would facilitate videoconferencing different kind of end points such as H.320 and H.323 end point as taught by Tucker.

### ***Response to Arguments***

Regarding rejection of claims 1-34 with respect to Double patenting rejection, Applicant's arguments are noted, but rejection is maintained, as applicant has not submitted the terminal disclaimer to overcome double patenting rejection.

### **Claim rejections-35 U.S.C 112**

Regarding rejection of claims 1-34 under 35 U.S.C 112 first paragraph, Applicant argues that "The current Specification is replete with explanations of the importance of of centralized processing capabilities and ability to allay the burdensome mixing tasks generally relegated to the end points. Some form of the word "central" (e.g. centralized) is ubiquitous in applicant's specification. Page 12 explains ... The Examiner is encouraged to re-read the specification to reinforce these points". Regarding this each

Art Unit: 2614

of the independent claims 1, 11, 19, 27 contain the limitations which are not disclosed in applicant's specification. For example independent claim 1 has limitation such as audio mixer being able to create a mixed stream which includes audio and video data, that may be communicated to one or more of the end points such that end points do not have to have to perform audio mixing. Applicant instead of pointing out where exactly in the specification he has support for this disclosure, indulges in making general statements such as specification replete with this information in responding to 112 rejection. To further elaborate, according this claim limitation: audio mixer is creating mixed stream which includes audio and video data, there is no support for this in applicant's specification because audio mixer can mix only audio streams to produce audio stream; but it cannot do this: creating mixed stream which includes audio and video data. Since applicant does not have support for this limitation in his specification, rejection of claims 1-39 under 112 first paragraph is maintained.

Rejection of claims 1-8, 11-18, 19-26, 27-34 under 35 U.S.C. 103(a) as being obvious over Smith et al. (US PAT: 6,128,649, hereinafter Smith) in view of Nelson (US2004/0008635A1, hereinafter Nelson, filed 7-10-2002): regarding rejection of the claims using the above combination, Applicant argues that "Applicant's are disappointed to see the Smith patent once again, as Applicant's have distinguished this reference countless times in this prosecution history. In this most recent analysis, Applicants submitted brief that described even more reasons why Smith is simply not germane to the allowability of the pending subject matter. Applicant's will not further enumerate all of the numerous reasons why Smith is not pertinent to the pending subject matter".

Art Unit: 2614

Regarding Smith reference, Applicant in his Appeal Brief, dated 11-23-2005, argued that Applicant's respectfully reminds the Examiner that in examining a patent application must first determine what is analogous prior art for the purpose of analyzing the obviousness of the subject matter at issue. In order to rely on a reference as a basis for rejection of applicant's invention, the reference must be in the field of applicant's endeavor or if not, then be reasonably pertinent to the particular problem with which the inventor was concerned. A reference is reasonably pertinent if, even though it may be in a different field from the that of the inventor's endeavor, it is one which ... would have commended itself to an inventor's attention when considering the problem". Regarding this argument, given the fact that Smith reference is submitted by the Applicant as part of IDS, his arguments regarding Smith reference being not relevant/or not analogous prior art to Applicant's invention must sound hollow. Nevertheless, Examiner would like to point out that Smith reference is analogous prior art because Smith teaches using his system for video conference for distributing audio and video streams (see Smiths patent).

Regarding Nelson reference used in the rejection, Applicant argues that "Nelson does not account for all the missing limitations of Smith. Concisely stated, if the Examiner would like to continue using bits and pieces of references for purposes of gluing tenuous 103 rejections, then he must find ... Smith is simply ill equipped to fulfill this role". Regarding this, Applicant has made no arguments regarding Smith reference in his response other than saying it is not a good base reference or Smith is not analogues art or Smith does not have centralized audio mixer, etc. Since Office action

above sets forth the rejections of applicant's claims addressing all the limitations ,  
rejection of claims is maintained.

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

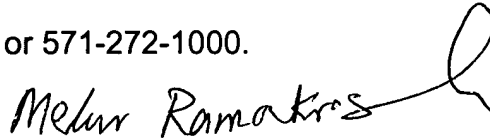
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melur Ramakrishnaiah whose telephone number is (571)272-8098. The examiner can normally be reached on 9 Hr schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curt Kuntz can be reached on (571) 272-7499. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2614

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Melur Ramakrishnaiah  
Primary Examiner  
Art Unit 2614